
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Koch, Robert A.

Group Art Unit: 2617

Application No. 10/717,892

Examiner: Desir

Filed: 20 November 2003

Attorney Docket: 02301 CON 2

Title: "System & Method for Providing Usage Monitoring Telephony Services"

37 C.F.R. § 1.8 CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically and/or facsimile transmitted to the United States Patent and Trademark Office.

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A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", is written over a faint, larger, stylized signature.

June 23, 2009

Date of Transmission

APPELLANT'S BRIEF IN SUPPORT OF APPEAL

Mail Stop: Appeal Brief — Patents
Commissioner for Patents

The Assignee/Appellant hereby submits a Brief in Support of Appeal for the above-identified application. The 37 C.F.R. § 41.20 (b) (2) large entity fee was electronically paid at submission.

A Notice of Appeal was filed May 4, 2009.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman". The signature is stylized with large, sweeping loops and a prominent vertical stroke in the center.

Scott P. Zimmerman
Reg. No. 41,390
Attorney for Appellant

REAL PARTY IN INTEREST

The real party in interest is AT&T Intellectual Property I LP, as the Assignee of U.S. Patent Application 10/717,892, as evidenced by an assignment recorded at reel/frame 014742/0322.

RELATED APPEALS AND INTERFERENCES

Counsel is not aware of any appeals or interferences that will directly affect, or be directly affected by, or have a bearing on, the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 1-3 and 5-19 are pending in this application.

Claims 1 and 11 are independent claims.

Claims 1-3, 5-8, 10-14, 16, and 18-19 were finally rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent No. 6,356,756 to Koster and further in view of U.S. Patent 6,195,422 to Jones *et al.*

Claims 9, 15, and 17 were finally rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* with *Koster* and *Jones* and further in view of U.S. Patent Application Publication 2003/0050100 to Dent.

The Appellant appeals the final rejection of claims 1-3 and 5-19.

STATUS OF AMENDMENTS

The claims hereby Appealed are based on the Amendment filed on August 8, 2008.

The final action was then mailed on December 11, 2008.

A request for reconsideration was then submitted February 9, 2009.

An Advisory Action was mailed April 8, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter generally relates to communications and to providing advanced services for communications. For example, many communications networks and/or service providers provide advanced services, such as call delivery options, call forwarding options, custom rings, voicemail, messaging, caller identification (caller ID), privacy director, and many other advanced services. These advanced services, though, may be too expensive for some providers. The infrastructure necessary to support such advanced telephony features, for example, is prohibitively expensive for some service providers. Many local-exchange carriers, wireless telephone service providers, IP-based telephone service providers, and the like cannot afford the expense of installing and maintaining the equipment that is required to provide advanced services. Exemplary embodiments thus provide advanced services to networks that lack the required infrastructure. When a network is unable to provide advanced services to a call, exemplary embodiments route the call to a service-providing network. The service-providing network provides an advanced service to the call. The service-providing network then routes the call to the intended destination (such as the dialed number). See U.S. Application 10/717,892 at paragraphs [0005], [0006], [0009], and [0011].

A) Independent Claim 1

In accordance with an exemplary embodiment, independent claim 1 recites a method for monitoring communications usage, comprising:

receiving a call routed from a dialed number in a native transport network to a virtual telephone number in a service-providing network, the native transport network having limited or no capability of providing advanced telephony service;

providing the advanced telephony service to the call, wherein the virtual telephone number utilizes the intelligent services provided by the service-providing network;

routing said call from the service-providing network to a terminating network destination; and

monitoring a duration of said call traversing the service-providing network.

Textual support for independent claim 1 is also provided. The receipt of the call and the dialed number are discussed at least at paragraphs [0027] and [0028] of the as-filed application. The native transport network, the virtual telephone number, and the service-providing network are discussed at least at paragraphs [0011], [0015] - [0018], [0026], and [0029]. The advanced telephony service is discussed at least at paragraphs [0009], [0011], and [0018]. The routing of the call is discussed at least at paragraphs [0016], [0023], and [0028]. The monitoring of the duration of the call is discussed at least at paragraphs [0015] and [0043].

B) Independent Claim 11

In accordance with another exemplary embodiment, independent claim 11 recites a system for monitoring communications usage, the system operative to:

receive a call routed from a dialed number in a native transport network to a virtual telephone number in a service-providing network, the native transport network having limited or no capability of providing advanced telephony service;

provide the advanced telephony service to the call, wherein the virtual telephone number utilizes the intelligent services provided by the service-providing network;

route said call from the service-providing network to a terminating network destination; and

monitor a duration of said call traversing the service-providing network.

Textual support for independent claim 11 is also provided. The receipt of the call and the dialed number are discussed at least at paragraphs [0027] and [0028] of the as-filed application. The native transport network, the virtual telephone number, and the service-providing network are discussed at least at paragraphs [0011], [0015] - [0018], [0026], and [0029]. The advanced telephony service is discussed at least at paragraphs [0009], [0011], and [0018]. The routing of the call is discussed at least at paragraphs [0016], [0023], and [0028]. The monitoring of the duration of the call is discussed at least at paragraphs [0015] and [0043].

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Appellant appeals the final rejection of claims 1-3, 5-8, 10-14, 16, and 18-19 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent No. 6,356,756 to Koster and further in view of U.S. Patent 6,195,422 to Jones *et al.*

The Appellant appeals the final rejection of claims 9, 15, and 17 under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* with *Koster* and *Jones* and further in view of U.S. Patent Application Publication 2003/0050100 to Dent.

ARGUMENTS

1. *Koster* Teaches Away

Koster teaches away and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference teaches away, including when a proposed modification “render[s] the prior art unsatisfactory for its intended purpose” or when the proposed modification “change[s] the principle of operation of a reference.” See M.P.E.P. § 2145 (X)(D). If *Fuller* is combined with *Koster*, as the Office proposes, then *Fuller*'s principle of operation must be changed, and these changes render *Fuller* unsatisfactory for its intended

purposes. Any proposed combination of *Fuller* with *Koster* cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejections of all pending claims.

Fuller and *Jones* are first explained. *Fuller* explains that a caller dials a single directory number, or “common ‘virtual fixed line’ number,” to reach a mobile subscriber. U.S. Patent 6,775,546 to *Fuller* (Aug. 10, 2004) at column 1, line 65 through column 2, line 12 (emphasis added). *Fuller* then explains that “the common virtual fixed line number is converted in Step 2 into two or more MSISDNs.” *Fuller* at column 6, lines 24-26 (emphasis added). The “two or more MSISDNs” have a “priority order.” *Id.* at column 6, lines 25-26. *Fuller* then attempts to reach the called party at the highest priority MSISDN. *See id.* at column 6, lines 25-45. *Jones* describes processing equipment that continuously evaluates the cost of a call for a duration of the call. The combined teaching of *Fuller* and *Jones* thus requires that a user dial a “common ‘virtual fixed line’ number,” and that dialed number is converted into two or more mobile numbers. That is, *Fuller* and *Jones* require that a caller dial a single directory number, or “common ‘virtual fixed line’ number,” to reach a mobile subscriber.

Koster’s principle of operation is entirely different. In *Koster* a caller dials a wireless number and the wireless number is “ported” or “mapped” to another number for a service platform. As *Koster* explains, a caller dials the subscriber’s wireless number. *See* U.S. Patent No. 6,356,756 to *Koster* at column 5, lines 55-56. *Koster* then **“maps the wireless directory number to the NPA-NXX directory number for the platform.”** *Id.* at column 5, lines 51-52 (emphasis added). The originating switch queries for routing instructions. *See id.* at column 5, lines 61-63. The call is then routed to the service platform. *See id.* at column 5, line 63 through column 6, line 3.

The Board must now realize that impermissible changes are required. If *Fuller* is combined with *Koster*, as the Office proposes, then *Fuller*’s principle of operation must be changed to convert a dialed directory number into a service platform’s directory number, as *Koster* teaches. Indeed, *Fuller*’s entire teaching of converting the dialed number into “two or more MSISDNs” must be **eliminated**. Moreover, *Fuller*’s teaching of dialing a single directory

number, or “common ‘virtual fixed line’ number,” to reach a mobile subscriber must be changed to dial a wireless number, as *Koster* teaches. *Fuller*’s principle of operation must also be changed to “port” or “map” the dialed wireless number to another number for a service platform, as *Koster* also teaches.

Koster thus teaches away. If *Fuller* is combined with *Koster*, as the Office proposes, then many changes to *Fuller*’s principle of operation are required. *Fuller*’s entire teaching of converting the dialed number into “two or more MSISDNs” must be eliminated. *Fuller*’s teaching of dialing a single directory number, or “common ‘virtual fixed line’ number,” to reach a mobile subscriber must be changed to dial a wireless number, as *Koster* teaches. *Fuller*’s principle of operation must also be changed to “port” or “map” the dialed wireless number to another number for a service platform, as *Koster* also teaches. The M.P.E.P., however, forbids changing a principle of operation to support a *prima facie* case for obviousness. Any proposed combination of *Fuller* with *Koster* cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejections of the pending claims.

2. The Examiner Cannot “Cherry Pick”

Examiner Desir argued that no change to *Fuller*’s principle of operation is required. Examiner Desir merely stated that *Fuller* “discloses dialing a number that is converted to a directory number.” Examiner Desire, Advisory Action mailed April 8, 2009, at page 2 (“Continuation of 11”). Yet a **reference must be considered as a whole, including portions that lead away from the claimed invention**. See M.P.E.P. at § 2141.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It seems that the Examiner wants to “cherry pick” only certain teachings of *Fuller* and ignore teachings that are unfavorable. The patent laws, however, forbid such action, and the Examiner is, instead, required to consider *Fuller*’s entire teachings. Because *Fuller*’s principle of operation must be changed, and even eliminated, the Office must respectfully remove the § 103 (a) rejections of the pending claims.

3. Claims 1-3, 5-8, 10-14, 16 & 18-19 are not Obvious over *Fuller* with *Koster & Jones*

Because *Koster* teaches away, claims 1-3, 5-8, 10-14, 16, and 18-19 cannot be obvious over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent No. 6,356,756 to Koster and further in view of U.S. Patent 6,195,422 to Jones *et al.* The Board is respectfully requested to REVERSE the final rejection of these claims. The Board is also respectfully requested to either allow these claims or to reopen prosecution.

4. Claims 9, 15, and 17 are not Obvious over *Fuller* with *Koster, Jones & Dent*

Because *Koster* teaches away, claims 9, 15, and 17 cannot be obvious over *Fuller* with *Koster* and *Jones* and further in view of U.S. Patent Application Publication 2003/0050100 to Dent. The Board is respectfully requested to REVERSE the final rejection of these claims. The Board is also respectfully requested to either allow these claims or to reopen prosecution.

CONCLUSION

In view of the foregoing reasons, the Appellant respectfully requests REVERSAL of the 35 U.S.C. § 103 (a) rejection of claims 1-3, 5-8, 10-14, 16, and 18-19 as being unpatentable over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent No. 6,356,756 to Koster and further in view of U.S. Patent 6,195,422 to Jones *et al.*

The Appellant also respectfully requests REVERSAL of the 35 U.S.C. § 103 (a) rejection of claims 9, 15, and 17 under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* with *Koster* and *Jones* and further in view of U.S. Patent Application Publication 2003/0050100 to Dent.

AUTHORIZATION FOR PAYMENT OF FEES

If there are any other fees due in connection with the filing of this brief in support of appeal, the Office is hereby authorized to charge the fees to the same credit card identified at

submission. If any additional fees are required, such as a fee for an extension of time under 37 C.F.R. § 1.136, such extension of time is requested and the fee should also be charged to the same credit card.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", with a stylized flourish at the end.

Scott P. Zimmerman
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CLAIMS APPENDIX

U.S. Patent Application No. 10/717,892 Pending Claims

1. A method for monitoring communications usage, comprising:

receiving a call routed from a dialed number in a native transport network to a virtual telephone number in a service-providing network, the native transport network having limited or no capability of providing advanced telephony service;
providing the advanced telephony service to the call, wherein the virtual telephone number utilizes the intelligent services provided by the service-providing network;
routing said call from the service-providing network to a terminating network destination; and
monitoring a duration of said call traversing the service-providing network.
2. The method of claim 1, further comprising monitoring a status of said call.
3. The method of claim 1, further comprising routing said call to an original destination via the separate native transport network.
4. (Canceled)
5. The method of claim 1, wherein said service-providing network is a network selected from the group consisting of a wireline network, a wireless network, and a packet-switching network.
6. The method of claim 1, further comprising associating the virtual telephone number to a wireless telephone number existing in the native transport network.

7. The method of claim 1, further comprising associating the virtual telephone number to another telephone number existing in the native transport network.
8. The method of claim 1, wherein said native transport network is a network selected from the group consisting of a wireline network, a wireless network, and a packet-switching network.
9. The method of claim 1, further comprising billing a telecommunications provider of said native transport network for said monitoring.
10. The method of claim 1, further comprising billing a subscriber based on said duration of said call.
11. A system for monitoring communications usage, the system operative to:

receive a call routed from a dialed number in a native transport network to a virtual telephone number in a service-providing network, the native transport network having limited or no capability of providing advanced telephony service;

provide the advanced telephony service to the call, wherein the virtual telephone number utilizes the intelligent services provided by the service-providing network;

route said call from the service-providing network to a terminating network destination; and

monitor a duration of said call traversing the service-providing network.

12. The system of claim 11, further operative to monitor a status of the call.
13. The system of claim 11, further operative to route said call to an original destination via the separate native transport network.

14. The system of claim 11, further operative to associate the virtual telephone number to another telephone number existing in the native transport network.
15. The system of claim 11, further operative to associate the virtual telephone number to a packet voice-based telephone number existing in the native transport network.
16. The system of claim 11, wherein said service-providing network comprises an Advanced Intelligent Network (AIN).
17. The system of claim 11, wherein said service-providing network comprises a packet-switching network.
18. The system of claim 11, wherein the service-providing network modifies messages accompanying the call so that the call is not routed back to the service-providing network in an endless loop.
19. The system of claim 11, wherein the service-providing network modifies caller information associated with the call.
20. (Cancel)

EVIDENCE APPENDIX

There are no submissions pursuant to 37 CFR § 41.37 (c) (ix) for U.S. Patent Application No. 10/717,892.

RELATED PROCEEDINGS APPENDIX

There are no submissions pursuant to 37 CFR § 41.37 (c) (x) for U.S. Patent Application No. 10/717,892.